

REMARKS

This Amendment is submitted in response to the Office Action dated June 4, 2003, having a shortened statutory period set to expire September 4, 2003.

In paragraph 2 of the present Office Action, Claims 5-6, 13-14, and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, Applicant has amended Claims 5-6, 13-14, and 21-22 to correct the lack of antecedent basis noted by the Examiner. Also in paragraph 2 of the present Office Action, the Examiner objects to Claims 1, 9, and 17 because of informalities. In response, Applicant has amended Claims 1, 9 and 17 to correct the improper punctuation. Applicant thanks the Examiner for these suggestions.

In the present Office Action, Claims 1-3, 7-11, 15-19, and 23-24 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,185,598 to *Farber et al.* (*Farber*). Claims 4-6, 12-14, and 20-22 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Farber* in view of U.S. Patent No. 5,813,007 to *Nielsen* (*Nielsen*). Those rejections are respectfully traversed in view of the discussion made herein, and favorable reconsideration of the claims is requested.

With respect to Claims 1-3, 7-11, 15-19, and 23-24, Applicant believes that *Farber* does not render the present claims unpatentable because *Farber* does not teach or suggest, and actually teaches away from, the method used in Applicant's invention. Applicant's invention determines whether a file request was sent to a server as the result of a link on the server or on a load balancing server and bases the invention's subsequent activity on the result of the foregoing determination. *Farber*, by contrast, merely determines whether the file request sent to a server arrived from a server or from a client, and then looks to the type of content requested (*Farber*, Col. 7, line 57 – Col. 8, line 4). *Farber* bases subsequent action on the foregoing pair of determinations, which are strikingly dissimilar to those employed in Applicant's invention.

Further, in Claim 1, Applicant claims multiple elements neither present nor suggested by *Farber*. First among them, Applicant claims “determining whether the client’s request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself.” The Examiner cites Col. 7, line 56- Col. 8, line 25 of *Farber* as providing similar functionality. Applicant respectfully submits that the only mention of determining the source of a request occurs when the method disclosed in *Farber* “determines whether the sender (client 106) is a browser or a repeater” (Col. 7, line 58). *Farber* then looks at the nature of the data requested in its attempt to “determine whether the resource requested is repeatable” (Col. 8, line 3). Neither of these steps attempts to determine how the client’s request was referred to the content server. The first attempts to make a decision based on the whether the requesting entity is a browser or a repeater. The second attempts to determine the processing of the request based on the type of item requested.

Also with respect to Claim 1, the Examiner correctly observes that *Farber* does not explicitly teach the step of sending to the client a file requesting that the client contact a load distribution server. Applicant respectfully submits that *Farber* does not teach, responsive to determining whether the client’s request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself, sending to the client a file requesting that the client contact the load distribution server. While *Farber* does mention the use of a redirect message (Col. 7, line 32), *Farber* makes no discussion of the conditional structure that triggers the redirect message. Applicant respectfully submits that, because *Farber* teaches away from the determining step discussed above, *Farber* also teaches away from any claimed method that is conditioned on acting “responsive to” the “determining” step.

The Examiner has further argued at the end of paragraph five that it would have been obvious to one of ordinary skill in the data processing art at the time of Applicant’s invention that *Farber* is equivalent to Applicant’s invention. The Examiner argues this noting that *Farber*

implicitly discloses the original server (102) or a reflector (108) sending back to the client a redirect response, which contains a new URL and directs the client to contact with another server or repeater is equivalent to the step of sending a to the client a file requesting that the client contact the load distribution server disclosed in Applicant's specification. The Examiner further observes that a person "of ordinary skill in the art would have recognized that Farber performs the same function in substantially the same way to reach substantially the same result."

Applicant respectfully submits that the Examiner's assertion of the equivalence of the two methods, even if assumed to be correct, does not form a basis for a rejection for obviousness. Obviousness requires, rather than equivalence, that the prior art show some motivation for the modification necessary to obtain the claimed invention. "It is insufficient [to establish a *prima facie* case of obviousness] that the prior art disclosed the components of [the invention], either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). Applicant respectfully submits that, in arguing equivalence to show obviousness, the Examiner neglects the critical element of showing the motivation for modification, which can not be supplied by a supposed "equivalence" of steps.

Moreover, Applicant respectfully submits that the Examiner's argument that *Farber's* method is equivalent to Applicant's invention neglects a key difference between *Farber* and Applicant's invention. As Applicant has previously noted, Applicant's invention determines whether a file request was sent to a server as the result of a link on the server or on a load-balancing server and bases the invention's subsequent activity on the result of the foregoing determination. *Farber*, by contrast, merely determines whether the file request sent to a server arrived from a server or from a client, and then looks to the type of content requested (*Farber*, Col. 7, line 57 – Col. 8, line 4). The result is that, while *Farber* only allows the server to determine the type of content requested and the type of requesting entity, Applicant's invention

allows the more sophisticated determination of the history of the requesting entity's interaction with the server. This more sophisticated determination provides a substantial advantage not seen in *Farber* in that it allows clients that have been interacting with the server to continue to do so, while clients that have been directed to the server by a bookmark can be steered away.

The foregoing argument made with respect to Claim 1 is also made with respect to Claims 2-8, which further limit and patentably distinguish Claim 1. The foregoing argument is also made with respect to Claims 9 and 17, which claim a computer program product and a system for performing Applicant's invention, respectively. The foregoing argument is similarly made with respect to Claims 10-16, which further limit and patentably distinguish Claim 9 and with respect to Claims 18-24, which further limit and patentably distinguish Claim 17.

The Examiner has also rejected Claims 4-6, 12-14 and 20-22 under 35 U.S.C. § 103(a) as unpatentable over *Farber* in view of U.S. Patent No. 5,813,007 to *Nielsen*. (*Nielsen*). As set forth in MPEP 2143, the first criterion for establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to...combine reference teachings." In evaluating motivation or suggestion to combine reference teachings, "a prior art reference must be considered in its entirety, i.e., as a whole" (emphasis in original). MPEP 2141.02, citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983) *cert. denied*, 469 U.S. 851 (1984).

When taken as a whole, *Farber* discloses a system for redirecting file requests among a series of repeaters in response to a request for a file being sent by a client. *Nielsen*, on the other hand, describes a system for updating the bookmarks stored on the client system in response to changes in the content of a file on the file server. In view of the teachings of the references as taken as a whole, it is apparent that there is no objective suggestion or motivation in the cited

references (or generally in the art) that would lead a skilled artisan to combine the reference teachings to obtain the present invention. If such suggestion or motivation existed, the Examiner would have, no doubt, cited by column and line number a passage in one of the references cited or a well known teaching in the art to discharge his duty to "explain why the combination of the teachings is proper." MPEP 2142, citing *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. Appl. & Inter. 1986). Instead, at page 8 of the first office action, the Examiner merely asserts:

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of *Farber* and *Nielsen*...because it would have been an efficient communications system.

Because the Examiner's combination of references is not supported by any objective teaching in the references or art, Applicant believes that the examiner has failed to establish a *prima facie* case of obviousness.

Further, Applicant respectfully submits that, were the combinations proposed by the Examiner performed, Applicant's invention as disclosed in Claims 4-6, 12-14, and 20-22 would not result. Claims 4-6, 12-14, and 20-22 further limit and patentably distinguish Claims 1, 9, and 17, respectively. Therefore, in order for the combination of *Farber* and *Nielsen* to sustain an obviousness rejection with respect to Claims 4-6, 12-14, and 20-22, *Nielsen* must correct the basic deficiency in *Farber* that prohibits *Farber* from rendering independent Claims 1, 9 and 17 obvious. Applicant has already shown that Claims 1, 9, and 17 are patentable over *Farber*, because *Farber* does not show the step of "determining whether the client's request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself." The Examiner has not argued that *Nielsen* shows this critical step, arguing instead that *Nielsen* merely shows the features that further distinguish the dependent Claims 4-6, 12-14, and 20-22 from independent Claims 1, 9, and 17. Without the critical step of "determining whether the client's request to receive a file from the content server

originated as a reference from the load distribution server or as a reference from the content server itself," the combination of *Nielsen* and *Farber* can not sustain an obviousness rejection of Claims 4-6, 12-14, and 20-22.

It is respectfully submitted that the claims are in condition for allowance and favorable action is requested. No extension of time is believed to be required. However, in the event that an extension of time is required, please charge that extension fee and any other required fees to IBM Corporation's Deposit Account Number 09-0447.

Applicant respectfully requests the Examiner contact the undersigned attorney of record at (512) 542-3678 if such would further or expedite the prosecution of the present Application.

Respectfully submitted,



Andrew J. Dillon

Reg. No. 29,634

BRACEWELL & PATTERSON, L.L.P.

P.O. Box 969

Austin, Texas 78767-0969

(512) 542-2100

ATTORNEY FOR APPLICANTS

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